



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,131	09/26/2003	Yukiko Murasawa	03310/019002	6115

7590 11/02/2004

Jonathan P. Osha
ROSENTHAL & OSHA L.L.P.
Suite 2800
1221 McKinney Street
Houston, TX 77010

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

mk

Office Action Summary

Application No.

10/672,131

Applicant(s)

MURASAWA ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6 and 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7 and 8 of U.S. Patent No. 6,616,992 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6 and 9 of the claimed invention are incorporated in claim 1 of 6,616,992 B2. Claims 10 and 11 of the claimed invention are incorporated in claim 3 of 6,616,992 B2. Claims 12 and 13 of the claimed invention are incorporated in claim 4 of 6,616,992 B2. Claim 14 of the claimed invention is incorporated in claims 7 and 8 of 6,616,992 B2.

3. Claims 6, 9 and 12-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 and 7 of U.S. Patent No. 6,649,232 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6 and 9 of the claimed invention

Art Unit: 1774

are incorporated in claim 1 of 6,649,232 B2. Claims 12 and 13 of the claimed invention are incorporated in claims 2 and 5 of 6,649,232 B2. Claim 14 of the claimed invention is incorporated in claim 7 of 6,649,232 B2.

4. Claims 6 and 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 16 and 17 U.S. Patent No. 6,777,038 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of the claimed invention is incorporated in claim 1 of 6,777,038 B2. Claim 10 of the claimed invention is incorporated in claim 4 of 6,777,038 B2. Claim 11 of the claimed invention is incorporated in claim 16 of 6,777,038 B2. Claim 12 of the claimed invention is incorporated in claim 17 of 6,777,038 B2.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Higuma et al. (US 5,059,983).

Higuma discloses a recording medium comprising a support, an ink retaining layer on the support, and an ink transporting layer on the ink retaining layer (abstract).

The ink retaining layer is equivalent to the claimed ink receptive layer, and the ink

Art Unit: 1774

transporting layer is equivalent to the claimed ink permeable layer. The ink transporting layer has a porous structure (col. 2, line 68), and comprises a particulate material and a binder (col. 3, line 4). The particulate material comprises silica, talc, calcium carbonate and aluminum hydroxide (col. 3, lines 20-31), and the binder comprises polyvinyl alcohol, acryl resin, polyvinyl acetate, ethylene-vinyl acetate copolymer, polyvinyl-acetal, epoxy resin and styrene-butadiene rubber (col. 3, lines 37-46). The mixing ratio of particulate materials to binder is preferably 10/1 to $\frac{1}{2}$ (col. 3, line 47). The thickness of the ink transporting layer ranges from 5-150 μm (col. 6, line 33). The ink retaining layer comprises hydrophilic polymers such as gelatin, starch, polyacryl-amide, polyvinylpyrrolidone, polyurethane, polyvinyl alcohol and polyester (col. 6, line 67 thru col. 7, line 14). The thickness of the ink retaining layer ranges from 1-30 μm (col. 7, line 15). The substrate can be made of polyester resin or glass plate (col. 7, line 19). The thickness of the substrate is 75 μm (col. 7, line 61). With respect to pore volume of the ink transporting layer, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Higuma reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant.

7. Claims 6-12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al. (US 5,027,131).

Hasegawa discloses a recording medium comprising a substrate, an ink retaining layer on the substrate, and an ink transporting layer on the ink retaining layer (col. 3, line 66 thru col. 4, line 5). The ink retaining layer is equivalent to the claimed ink receptive layer, and the ink transporting layer is equivalent to the claimed ink permeable layer. The substrate can be plastic film such as polyethylene terephthalate, polyester, celluloid and polyvinyl chloride, or glass plate (col. 4, line 9). The thickness of the substrate ranges from 1-5000 μm (col. 4, line 19). The ink transporting layer has a porous structure (col. 4, line 45), and comprises particles and a binder (col. 4, line 55). Silica is used as the particle ink the ink transporting layer (col. 4, line 67). The binder in the ink transporting layer comprises polyvinyl alcohol, acryl resin, polyvinyl acetate, ethylene-vinyl acetate copolymer, epoxy resin and styrene-butadine rubber (col. 6, lines 1-16). The mixing ratio of particulate materials to binder is preferably 1/5 to 50/1 (col. 6, line 25). The thickness of the ink transporting layer ranges from 1 to 300 μm (col. 6, line 37). The thickness of the ink retaining layer ranges from 1-70 μm (col. 7, line 14). The ink retaining layer comprises hydrophilic polymer such as gelatin, starch, polyamide, polyacryl-amide, polyvinylpyrrolidone, polyurethane, polyvinyl alcohol and polyester (col. 7, lines 17-31). With respect to pore volume of the ink transporting layer, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the


Hasegawa reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Betelhem Shewareged
October 30, 2004.